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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/516,553	11/30/2004	Tadaaki Yabubayashi	09853/0202140-US0	7061
7278 7	590 09/05/2006		EXAMINER	
DARBY & DARBY P.C.			POHNERT, STEVEN C	
P. O. BOX 525 NEW YORK.	7 NY 10150-5257		ART UNIT PAPER NUMBER	
· · - · - · - · - · - · - · - · - ·		,	1634	
			DATE MAILED: 09/05/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)	
	10/516,553	YABUBAYASHI ET AL.	
Office Action Summary	Examiner	Art Unit	
	Steven C. Pohnert	1634	
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with th	e correspondence address	
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period w - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICAT 36(a). In no event, however, may a reply b will apply and will expire SIX (6) MONTHS for cause the application to become ABANDO	ON. The timely filed From the mailing date of this communication. FOR INST (35 U.S.C. § 133).	
Status			
1)⊠ Responsive to communication(s) filed on 30 No	ovember 2004.		
, ————————————————————————————————————	action is non-final.		
3) Since this application is in condition for allowar		prosecution as to the merits is	
closed in accordance with the practice under E			
Disposition of Claims			
4) Claim(s) 1-22 is/are pending in the application.			
4a) Of the above claim(s) is/are withdray			
5) Claim(s) is/are allowed.			
6) Claim(s) is/are rejected.			
7) Claim(s) is/are objected to.			
8) Claim(s) 1-22 are subject to restriction and/or e	election requirement.		
Application Papers			
9) The specification is objected to by the Examine	r.		
10) The drawing(s) filed on is/are: a) acce	epted or b) objected to by the	e Examiner.	
Applicant may not request that any objection to the	drawing(s) be held in abeyance.	See 37 CFR 1.85(a).	
Replacement drawing sheet(s) including the correcti	ion is required if the drawing(s) is	objected to. See 37 CFR 1.121(d).	
11)☐ The oath or declaration is objected to by the Ex	aminer. Note the attached Off	ce Action or form PTO-152.	
Priority under 35 U.S.C. § 119			
12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of:	priority under 35 U.S.C. § 119	(a)-(d) or (f).	
 Certified copies of the priority documents 	s have been received.		
Certified copies of the priority documents	s have been received in Applic	ation No	
Copies of the certified copies of the prior	ity documents have been rece	ived in this National Stage	
application from the International Bureau	, ,,		
* See the attached detailed Office action for a list	of the certified copies not rece	ived.	
Attachment(s)	_		
1) Notice of References Cited (PTO-892)	4) Interview Summ Paper No(s)/Mai		
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)		al Patent Application (PTO-152)	
Paper No(s)/Mail Date	6) Other:		

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DETAILED ACTION

Election/Restrictions

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - Claims 1-14, drawn to method of detecting a nucleic acid, classified in class 435, subclass 6.
 - II. Claim15-22, drawn to a biochip product, classified in class 435, subclass 283.1.

The inventions are distinct, each from the other because of the following reasons:

- 2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case detecting a nucleic acid can be accomplished by using a microarray, PCR, northern blot or southern blot. The process claimed can thus be accomplished with a materially different product.

 Searching the art for methods of detecting nucleic acid would not necessarily result in art of biochips and vice versa. Thus searching the art for groups I and II would result in a search burden on the office.
- 3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

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4. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

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Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103 (a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven C. Pohnert whose telephone number is 571-272-3803. The examiner can normally be reached on Monday-Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on 571-272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Steven Pohnert

Det Paut

JEHANNE SITTON
PRIMARY EXAMINER

8/31/06